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08/2505/711	03/15/97	EIGEN	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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MM41/0405
JACOBSON PRICE HOLMAN & STERN
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WASHINGTON DC 20004

EXAMINER

ART UNIT	PAPER NUMBER
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2856

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DATE MAILED: 04/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/750715

Applicant(s)

Ergon et al

Examiner

Tom No. 1.0

Group Art Unit

2856

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/16/99.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 33-46, 53-59 and 67 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 33-46, 53-59 and 67 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The amendment filed March 16, 1999 has been entered. It is noted claim 64 was previously canceled.
2. The finality of the previous actions withdrawn in view of the error in describing Eigen et al as a 102(b) reference when whether it should have been referred to as a 102(a) or 102(b) reference was ambiguous.
3. Claims 33-46, 53-59 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 33, line 2 "aid" should be ---said---. In claim 38, line 3 "charges" should be ---charged---. There is no antecedent for "said pores" in line 8. To overcome it is suggested that "said pores" be replaced with ---pores therebetween---. Claiming of alternatives as in claim 36 is unclear in view of the disparagy between the alternatives and thus it should be claimed in a Markush type claim.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 33 is rejected under 35 U.S.C. 102(a) as being anticipated by Eigen et al.
Note especially the abstract and the first two text paragraphs on pages 5740 and 5741.
6. Claims 33-46, 53-59 and 67 are rejected under 35 U.S.C. 112, first paragraph, as

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containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood from page 6, lines 2-14 or elsewhere in the disclosure how the generated signal defines the volume element, determines the time to transfer the volume element, and controls the transfer as set forth in claim 33. How this is done does not appear to be readily apparent to one of ordinary skill in the art and appears to be material essential to understanding the invention and thus directed to the heart of the invention. A reference to an unpublished non U.S. patent application cannot substitute for disclosure of essential material. Even if such material can be shown to be present therein it must be specifically inserted to the specification when such is the source. It must also be shown that such source was clearly referred to as such a source in the original disclosure.

7. Claims 33-46, 53-59 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al, Ashkin et al, North Jr., Gohde et al or Weber et al.

The reasons for obviousness are substantially equivalent to those given in paragraph 13 of paper nor 8, mailed Jan. 30, 1998 since any differences appear known or obvious to one of ordinary skill in the sample handling and analysis arts since similar such techniques are known or obvious therein and as suggested by applicants arguments against the 35 U.S.C. 112(1) rejection while suggests that such differences are known in the art or obvious to one of ordinary skill therein. I.e. the transferring steps appear obvious based upon Applicants arguments supporting enablement that such transferring would have been obvious from the prior art. Other steps such

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as use of a piston pump, use of optical waveguides, etc. are clearly well known in the sample handling and analysis arts and would have been obvious to use as claimed in view of their well known utility for such purposes.

8. Applicant's arguments filed March 16, 1999 have been fully considered but they are not persuasive. Applicants evidence against the 102(b) rejection using Eigen et al was persuasive. Since it appears applicant should have then anticipated a 102(a) rejection here provision of a certified translation of the priority document, if done, should include an explanation of why it was not provided earlier. Applicants other arguments are believed overcome for the reasons given in the rejection.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (703) 305-4765.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

4/1/99
Thomas P. Noland
Primary Examiner
Art Unit 2856

Thomas Noland

Noland/dc
March 29, 1999